

### REMARKS

Claims 1-21 are pending in the application and have been examined. The specification has been objected to. The Oath has been objected to. The drawings have been objected to. Claims 1-8 have been rejected under 35 U.S.C. § 102(e) as being anticipated by Lawlor, et al. (U.S. Patent No. 5,870,724). Claim 9 has been rejected under 35 U.S.C. § 103(a) as being unpatentable over Lawlor in view of Pascoe (U.S. Patent No. 5,813,015). Claim 10 is rejected under § 103(a) as being unpatentable over Konya (U.S. Patent No. 5,937,396) in view of Pascoe. Claims 11-21 have been rejected under § 103(a) as being unpatentable over Konya in view of Pascoe further in view of Lawlor. In light of the above amendments and below remarks, reconsideration of the present application is respectfully requested.

On page 2 of the Office Action, the specification and abstract have been objected to because of certain typographical errors. Applicants have carefully reviewed the specification and have made the corrections as indicated in the Office Action. Withdrawal of the objection to the specification is therefore respectfully requested.

On page 2 of the Office Action, the Oath has been objected to as not indicating that the person making the Oath believes the inventors are the "first inventors of the claimed subject matter." Applicants are in the process of executing a substitute Declaration correcting this error and shall submit the same when completed. The original Declaration was based on an older Oath which did not contain this requirement. Applicants respectfully request that the objection to the Oath be held in abeyance until the substitute Declaration has been filed.

On page 3 of the Office Action, the drawing has been objected to because the Issuer 135 is not visible. Applicants submit herewith a red-lined copy of Figure 3 correcting this condition. This change to Figure 3 adds no new matter. Approval of this drawing correction is respectfully requested.

Claims 1-8 have been rejected under § 102(e) as being anticipated by Lawlor. Applicants respectfully traverse this rejection. With respect to the “receiving” limitation of independent claim 1, the Office Action states that Lawlor at column 29, lines 12-13 teaches this limitation. Applicants respectfully disagree. Claim 1 at lines 4-5 requires that the transaction data received contains “account numbers”. In contrast to this requirement of claim 1, at the portion of Lawlor designated in the Office Action, it is merely stated that terminal 54 receives data from a central computer. There is no discussion whatsoever at this portion of Lawlor of receiving transaction data, let alone transaction data including account numbers as required by claim 1.

Claim 1 at lines 5-6 further requires identifying non-issuer account numbers that represent accounts that are not issued by an issuer. The Office Action states that Lawlor at column 4, lines 13-16 teaches this limitation. Applicants respectfully disagree. Lawlor at this portion of its specification is discussing the operation of an ATM network. In contrast to the specific limitation of independent claim 1, an ATM network merely enables a customer to access its own account (in certain cases at a different bank than at which the ATM machine is located). The general discussion of an ATM network does not read on this specific limitation of independent claim 1 which requires the identification of account numbers that are not related to an issuer.

The final limitation of claim 1 at lines 7-9 requires the matching of the identified non-issuer account numbers with account numbers that represent accounts issued by the issuer. In the analysis contained in the Office Action, it is stated that Lawlor column 13, lines 51-54 and in Figure 1 teaches “a system architecture that permits a combination of information access”. This general teaching of Lawlor is frankly irrelevant to the above described limitation of independent claim 1. Lawlor at this portion of the specification and in Figure 1 is merely teaching that different combinations of information can be accessed from its database. Lawlor clearly does not teach or suggest a matching between non-issuer account numbers and issuer account numbers as explicitly required by independent claim 1.

As Applicants have shown that Lawlor does not teach any of three limitations of independent claim 1, let alone all three in combination, withdrawal of the anticipation rejection on the basis of Lawlor is respectfully requested.

The remainder of the rejected claims 2-8 are each dependent on independent claim 1 and build upon the identification and matching steps described above with respect to independent claim 1. As Lawlor does not teach or suggest either of these steps in independent claim 1, all of the above arguments with respect to independent claim 1 apply equally to dependent claims 2-8. Withdrawal of the anticipation rejection of dependent claims 2-8 on the basis of Lawlor is therefore respectfully requested.

On page 7 of the Office Action, claim 9 has been rejected as obvious over Lawlor in view of Pascoe. Applicants respectfully traverse this rejection. It is first noted that Pascoe does not cure any of the deficiencies described above in Lawlor with respect to independent claim 1. As claim 9 is dependent on claim 1, all of the above arguments apply equally to dependent claim 9. The Pascoe reference has been added for its teaching of "scrubbing" action taken on the transaction files. Applicants agree that Pascoe teaches such a "scrubbing" method. Applicant respectfully disagree that the general teaching of "scrubbing" in Pascoe teaches the explicit requirement of claim 9 which specifically requires that two types of data be eliminated from the transaction data. Eliminating unnecessary redundant data is of course generally beneficial, but the key in independent claim 9 is the identification of which data is unnecessary and which data is redundant. In the context of dependent claim 9, Pascoe does not teach specifically which type of data to eliminate from the data that is a subject matter of the claimed invention. Withdrawal of the rejection of dependent claim 9 is therefore respectfully requested.

On page 8 of the Office Action, claim 10 has been rejected as being unpatentable over Konya in view of Pascoe. Applicants respectfully traverse this rejection. Konya teaches a system for transferring money between ATM machines. As described above with respect to the disclosure in Lawlor of the ATM system, the ATM system is merely used to identify the

bank account of a user. Konya does not teach the explicit limitation of claim 10 of associating non-issuer account numbers with issuer account numbers. At the portion of Konya cited in the Office Action for teaching this limitation, Konya merely describe how the ATM network uses the routing code to identify the users' bank account. This disclosure has nothing to do with associating non-issuer account numbers and issuer account numbers as explicitly required by independent claim 10.

In the remainder of the rejection of independent claim 10, the Office Action admits that Konya does not teach any of the remaining limitations of claim 10. Specifically, with respect to the eliminating step, the Office Action states that Pascoe teaches this limitation. Applicant respectfully disagrees for the reasons described above. Pascoe generally teaches the scrubbing of files, but as described above, the present invention as recited in independent claim 10, requires the elimination of new transaction data which contains accounts number representing issuer accounts of customers of an issuer. This is neither taught nor suggested by Konya or Pascoe.

Claim 10 further requires generating a list of account numbers which are not issuer account numbers (lines 10-12). The Office Action takes official notice that it is well known in the computer art to generate a new list of information from an original list. Applicant agrees with the notice taken by the Office Action but disagrees that the specific requirements for generating the list as required in claim 10 are well known in the computer art. Specifically, generating a list of account numbers from the transaction data which are not issuer account numbers is clearly not know to those skilled in the art.

The Office Action further admits that Konya does not teach the identifying step of independent claim 10. This step requires identifying account numbers in the list which represent accounts owned by the customers. In rejecting this limitation, the Office Action relies on the general teaching of Pascoe that a file can be searched based on search parameters or other criteria. Again, this general teaching of searching by Pascoe does not read on the specific limitation of independent claim 10 in which accounts owned by the

customers (which are non-issuer accounts) are identified.

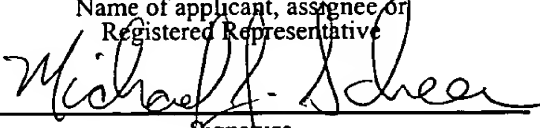
In light of the above remarks, withdrawal of the rejection of claim 10 on the basis of the combination of Konya and Pascoe is respectfully requested.

On page 9 of the Office Action, claims 11-21 are further rejected as being unpatentable over Konya in view of Pascoe further in view of Lawlor. Applicants respectfully traverse this rejection. As claims 11-17 are dependent on claim 10, all of the above arguments with respect to independent claim 10 apply equally to dependent claims 11-17 and withdrawal of the rejection of these claims is respectfully requested.

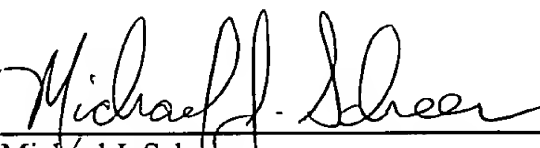
Independent claim 18 has been rejected as comprising the same steps as in claims 3, 5, 10, 12 and 17. Applicant agrees that claim 18 is a more narrow method claim than independent claim 10. For the above reasons discussed with respect to independent claims 1 and 10, withdrawal of the rejection of independent claim 18 is respectfully requested. As claims 19-21 are dependent upon independent claim 18, withdrawal of the rejection of these claims is also respectfully requested.

Applicants have shown that none of the references of record, specifically Lawlor, Pascoe and Konya teach or suggest the explicit limitations of each of independent claims 1, 10 and 18 nor their dependent claims. Withdrawal of all of the rejections on the basis of prior art is therefore respectfully requested. As each of the claims of the present application are currently in condition for allowance, such action is earnestly solicited.

I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as First Class Mail in an envelope addressed to: Asst. Commissioner for Patents, Washington, D.C. 20231, on April 28, 2000:

\_\_\_\_\_  
Michael J. Scheer  
Name of applicant, assignee, or  
Registered Representative  
  
\_\_\_\_\_  
Signature  
\_\_\_\_\_  
April 28, 2000  
\_\_\_\_\_  
Date of Signature

Respectfully submitted,

  
\_\_\_\_\_  
Michael J. Scheer  
Registration No.: 34,425  
OSTROLENK, FABER, GERB & SOFFEN, LLP  
1180 Avenue of the Americas  
New York, New York 10036-8403  
Telephone: (212) 382-0700

SIW/MJS:swu